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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER PICH, PONNOREAY	
			ART UNIT 2135	PAPER NUMBER

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/879,743

Applicant(s)

MAHER ET AL.

Examiner

Ponnoreay Pich

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 April 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/2/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1-16 have been examined and are pending.

#### ***Priority***

The examiner recognizes the applicant's right to an earlier effective filing date of 6/9/2000 based on priority claims from provisional application 60/210479.

#### ***Information Disclosure Statement***

The IDS submitted by the applicant have been considered by the examiner.

#### ***Drawings***

The drawings are objected to because in Figure 1, in the figure for "Credential Application," part of the text in the figure overlaps with another part of the figure making the text hard to read. Also, in Figure 7, the text for item 704 doesn't fit in the figure well; the applicant may wish to consider using a smaller sized font or bigger figure to contain the text. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

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application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The use of the trademarks InterRights Point, DigiBox, and DigiFile have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

The disclosure is objected to because of the following informalities: in paragraph 024, the word "in" should be removed.

Appropriate correction is required.

### ***Claim Objections***

Claim 11 is objected to because of the following informalities: "an certificate" should be changed to "a certificate". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Puri et al (US 6,260,043).

**Claim 1:**

Puri discloses a method for managing the use of electronic content, the method including:

1. Executing an application program, the application program being capable of rendering electronic content, the application program having at least a first predefined attribute associated therewith (col 7, lines 18-2).
2. Requesting the application program to render a piece of electronic content, the piece of electronic content having at least a second predefined attribute associated therewith, and the piece of electronic content further having associated therewith at least one rule, the rule specifying that the piece of electronic content may be rendered by application programs having the first predefined attribute associated therewith (col 4, lines 20-24 and 45-47).
3. Verifying the association of the second predefined attribute with the piece of electronic content (col 4, lines 63-66).
4. Verifying the association of the first predefined attribute with the application program (col 7, lines 60-65).
5. Rendering the content using the application program (col 5, lines 13-16).

Note that in Puri's method, the application program has a predefined attribute in that it meets a certain set of criteria that enables it to render electronic contents of specific formats. The electronic content itself has a second predefined attribute in the form of the file extension or internal structure of the file (col 4, lines 63-66). This extension/structure inherently defines a rule specifying that only applications capable of rendering files with this extension/structure may render the electronic content. Puri discloses that the formats that the application is able to render/convert may be specified to be inclusive or exclusive (col 7, lines 60-65). Therefore, at some point the application program must check the extension or structure of the file and check to see if it can render that specific type of file by verifying its first attribute.

The examiner would like to note that Puri teaches more than just a file format converter. He also teaches that the limitations recited in claim 1 are so broad as to apply to other applications that existed at the time the applicant's invention was made, i.e. WORD or WordPerfect. The examiner would also like to note that the first and second attributes are not limited to the ones explicitly disclosed by Puri. Puri also teaches that files inherently have certain attributes associated with them when they are created or modified and that programs accessing those files also inherently have the attribute that they check for those file attributes when attempting to access those files.

**Claim 2:**

Puri further discloses the first predefined attribute is generated by a first entity (col 7, lines 63-66). Puri does not explicitly disclose the second predefined attribute is generated by a second entity different from the first entity. However, Puri discloses that

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a file in WordPerfect format may be converted to WORD format (col 7, lines 20-24), thereby disclosing programs which creates files in a certain format. The examiner considers the program that created the foreign file format (i.e. WordPerfect) to be a different entity than the one specifying the formats that may be converted or rendered by the application (i.e. WORD). Therefore, the second predefined attribute is generated by a second entity different from the first entity is inherent to Puri's invention.

**Claim 16:**

Puri discloses the step of verifying the presence of the second predefined attribute is performed during or after the step of verifying the presence of the first predefined attribute (col 8, lines 7-10 and 19-21).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Puri et al (US 6,260,043) in view of "SDMI Portable Device Specification, Part 1, Version 1.0" hereafter referred to as "SDMI".

**Claim 3:**

Puri does not disclose the first entity comprises an association of one or more content providers, and the first predefined attribute is associated with the application

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program if the application program meets certain predefined criteria set by the association. However, the Secure Digital Music Initiative is an association known at the time the applicant's invention was made. The members of the association consist of about 200 companies who are electronic content providers. SDMI discloses that an application is SDMI-Compliant if it conforms to the requirements set forth in the specification published by the members of the Secure Digital Music Initiative (p6; definition 3.5). The Secure Digital Music Initiative and its specification shows that content providers are interested in security control of their content to the extent of even specifying what set of criteria an application must meet before being allowed legally access/render the content. They also show that it was possible at the time the applicant's invention was made to do provide such control.

It would have been obvious for one of ordinary skill in the art at the time of the applicant's invention was made to modify Puri's method according to the limitation recited in claim 3 in light of SDMI's teachings. One of ordinary skill would have been motivated to modify Puri's method in light of SDMI's teachings as it would allow content providers to have better security and control over their contents.

Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puri et al (US 6,260,043) in view of "SDMI Portable Device Specification, Part 1, Version 1.0" hereafter referred to as "SDMI" further in view of Sullivan et al (US 6,662,365).

**Claim 4:**



Neither Puri nor SDMI discloses the second entity comprises an entity concerned with controlling the nature of the electronic content that is rendered by the application program, and the second attribute is associated with the electronic content if the electronic content meets certain predefined standards. However, Sullivan discloses that at the time the applicant's invention was made, there existed an entity concerned with controlling the nature of electronic content, i.e. parents or the MPAA (col 1, lines 16-18). Sullivan further discloses that it was well known that television programs use MPAA ratings if the program meets certain criteria such as violence being found in the program (col 1, lines 33-44).

It would have been obvious for one of ordinary skill in the art at the time applicant's invention was made to further modify the combination method of Puri and SDMI in light of Sullivan's teachings according to the limitations recited in claim 4. One of ordinary skills would have been motivated to do so as it would allow for the electronic content to be rated and for parents to control if their children were allowed to access the content or not based on the ratings.

**Claim 5:**

Neither Puri nor SDMI discloses the second entity comprises a private or governmental entity that determines whether content is appropriate for minors, and the second attribute indicates that the content is deemed to be appropriate for minors. However, Sullivan discloses that at the time the applicant's invention was made, it was well known that MPAA ratings were used to determine whether the content is appropriate for minors (col 1, lines 33-44 and col 8, lines 31-36).

It would have been obvious for one of ordinary skill in the art at the time the applicant's invention was made to further modify the combination method of Puri and SDMI according to the limitations of claim 5 in light of Sullivan's teachings. One of ordinary skills would have been motivated to do so for the same reasons as in claim 4.

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puri et al (US 6,260,043) in view of "SDMI Portable Device Specification, Part 1, Version 1.0" hereafter referred to as "SDMI" further in view of Lion (US 6,330,491).

**Claim 6:**

Neither Puri nor SDMI discloses the piece of electronic content comprises a prescription, and in which the first entity associates the first attribute with the application program if it is determined that the application program will handle the prescription with at least a predefined level of security. However, Lion discloses the piece of electronic content comprises a prescription, i.e. Rx (col 3, lines 53-64). Further, Lion discloses an Rx vending machine (RVM) which requires that a user be authenticated before it can be used (col 4, lines 41-54). Lion also discloses that only RVM's associated with the network can be used to fill prescriptions (col 6, lines 10-13).

In light of how dangerous some prescription medications are, it is especially important that the application program which reads digital prescriptions and dispenses the medication have some predetermined level of security so that some first entity could reasonably entrust it to fill prescriptions safely. It is also important that the identity of everyone involved in filling the prescription be verified for safety reasons from the

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physician issuing the prescription, the pharmacist who fills the prescription, to the user/patient who gets the prescription. Therefore, it would have been obvious for one of ordinary skill in the art at the time the applicant's invention was made to further modify the combination method of Puri and SDMI according to the limitations of claim 6 in light of Lion's teachings. One of ordinary skills would have been motivated to do so as it would allow for electronic prescriptions to be written and filled in a secure manner.

**Claim 7:**

Neither Puri nor SDMI discloses the predefined level of security includes a requirement that the application verify that an application user has a predefined certificate before rendering the prescription. However, Lion discloses the predefined level of security includes a requirement that the application verify that an application user has a predefined certificate before rendering the prescription (col 3, lines 53-64 and col 5, lines 47-52).

It would have been obvious for one of ordinary skill in the art at the time applicant's invention was made to further modify the combination method of Puri, SDMI, and Lion according to the limitations of claim 7. One of ordinary skill would be motivated to do so for the same reasons given in claim 6.

**Claim 8:**

Neither Puri nor SDMI discloses the predefined certificate indicates that the user is a licensed pharmacist. However, Lion discloses the predefined certificate indicates that the user is a licensed pharmacist (col 5, lines 47-52).

It would have been obvious for one of ordinary skill in the art at the time applicant's invention was made to further modify the combination method of Puri, SDMI, and Lion according to the limitations of claim 8. One of ordinary skill would be motivated to do so for the same reasons given in claim 6.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Puri et al (US 6,260,043) in view of "SDMI Portable Device Specification, Part 1, Version 1.0" hereafter referred to as "SDMI" further in view of Lion (US 6,330,491) further in view of Hsu et al (US 5,982,898).

**Claim 9:**

Puri and SDMI does not explicitly disclose a certified pharmacist is identified by an attribute issued by a third entity different from the first and second entity. However, Lion discloses a certified pharmacist is identified by an attribute (col 5, lines 47-52). Lion also does not explicitly disclose wherein said attribute is issued by a third entity different from the first and second entity. However, independent or third party entities which verify a user's identity and issues certificates which authenticates the user to other parties were well known at the time the applicant's invention was made as disclosed by Hsu (col 1, lines 32-51).

It would have been obvious for one of ordinary skill in the art at the time applicant's invention was made to further modify the combination method of Puri, SDMI, and Lion according to the limitations of claim 9 in light of Hsu's teachings. One of ordinary skills would have been motivated to do so as it would have resulted in better

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security and more reliability that a user (i.e. the physician, pharmacist, patient, or some other user) is who they claim to be.

Claims 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puri et al (US 6,260,043) in view of "SDMI Portable Device Specification, Part 1, Version 1.0" hereafter referred to as "SDMI" further in view of Sullivan et al (US 6,662,365) further in view of Lion (US 6,330,491) and Hsu et al (US 5,982,898)

**Claim 10:**

Puri, SDMI, and Sullivan do not disclose the second entity associates the second attribute with the prescription if the prescription originated from a certified physician. However, Lion discloses a pharmacist verifying the validity of an electronic prescription request by contacting the prescribing physician (col 5, lines 26-29). This shows that having to verify the physician's identity listed on the electronic prescription was a known concern at the time the applicant's invention was made. Further, as mentioned in claim 9, Hsu discloses that one known way of verifying a party's identity with a reasonable degree of confidence is with some sort of certificate issued by an independent party, i.e. the second entity (col 1, lines 32-51).

Therefore, it would have been obvious at the time the applicant's invention was made to further modify Puri's method according to the limitations recited in claim 10 in light of Lion and Hsu's teachings. One of ordinary skill would have been motivated to do so for the same reasons given in claims 6 and 9. One of ordinary skills would have further been motivated to do so because having a second entity associate a second

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attribute with the prescription gives further confidence that the prescription was checked for validity.

**Claim 11:**

Puri, SDMI, and Sullivan do not disclose a certified physician is identified by a certificate issued by a third party entity different from the first and second entities. However, Lion discloses having to verify a physician's identity (col 5, lines 26-29). Further, Hsu discloses that one known way of verifying a party's identity with a reasonable degree of confidence is with some sort of certificate issued by an independent party (col 1, lines 32-51).

Therefore, it would have been obvious at the time the applicant's invention was made to further modify Puri's method according to the limitations recited in claim 11 in light of Lion and Hsu's teachings. One of ordinary skills would have been motivated to do so for the same reasons given in claim 6.

**Claim 12:**

Puri, SDMI, Sullivan, Lion, and Hsu do not explicitly disclose the second entity determines that a prescription originates from a certified physician by checking for the presence of the certificate issued by the third entity. However, the step recited in claim 12 must be done for the second entity to verify that the prescription originated from a certified physician.

**Claim 13:**

Puri, SDMI, Sullivan, and Lion do not explicitly disclose the rendering application is further associated with a fourth attribute, the fourth attribute attesting to a

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determination having been made by a fourth entity that the application program possesses a predefined functionality. However, Hsu discloses that verification by an independent party was well known at the time the applicant's invention was made (col 1, lines 32-51). Further, as mentioned previously in claim 3, SDMI teaches that content providers are interested in controlling their electronic content and would want to verify that an application accessing their electronic content meets certain criteria.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the applicant's invention was made to further modify Puri's method according to the limitations recited in claim 13 in light of Hsu and SDMI's teachings. One of ordinary skill would have been motivated to do so because it would allow for assurance to the electronic content provider that the application accessing their electronic content meets certain criteria.

**Claim 14:**

Puri, SDMI, Sullivan, Lion, and Hsu do not explicitly disclose the predefined functionality includes functionality that ensures that the application program verifies the presence of the second attribute before rendering the electronic content. However, the limitation recited in claim 14 must exist in Puri's modified method. The reason it must exist is that as discussed, content providers are interested in controlling their electronic content and programs which access those electronic contents. The only way they can be assured of this control is if there exists some functionality in the application which checks for the presence for the second attribute before rendering the electronic content.

**Claim 15:**

Puri, SDMI, Sullivan, Lion, and Hsu do not explicitly disclose verifying the association between the application and the fourth attribute. However, this limitation must exist for the content providers to have reasonable assurance that the application accessing their contents has been verified to meet certain criteria.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. [http://www.sdmi.org/who\\_we\\_are.htm](http://www.sdmi.org/who_we_are.htm) (last visit 3/7/2005).
2. <http://www.sdmi.org/FAQ.htm> (last visit 3/7/2005).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 8:00am-4:30pm Mon-Fri.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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PP

  
KIM VU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100